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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,272	03/27/2001	Scott McKay	E16.2-9822	9236

490 7590 10/20/2004

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

HRUSKOI, PETER A

ART UNIT

PAPER NUMBER

1724

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,272

Applicant(s)

MCKAY, SCOTT

Examiner

Peter A. Hruskoci

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 26-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claims 1, 9, 26, and 30-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In claims 1, 9, and 26 "an overall basic pH", in claims 30 and 32 "high level of water and minerals", and in claims 31 and 33 "does not produce...chlorine" lack clear antecedent basis in the specification as originally filed, and appear to be drawn to new matter.

Claims 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 30 and 32 "high level" and in claims 31 and 33 "significant" are vague and indefinite because it is unclear how these terms further limit the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10, and 26-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/31636 McKay in view of Jansen 4,790,946. McKay discloses (see pages 10-16) the structure of the cooling and water treatment systems substantially as claimed. The claims differ from McKay by reciting that the titanium electrode is coated with ruthenium. Jansen disclose (see col. 5 line 39 through col. 6 line 14) that it is known in the art to utilize a titanium electrode with an iridium or ruthenium coating in a system for disinfecting water. It would have been obvious to one skilled in the art to modify the systems of McKay by utilizing the recited titanium

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electrode in view of the teachings of Jansen, to aid in disinfecting water. The specific pH, level of metals and minerals, and amount of chlorine in the water treated in McKay, appears to be patentably indistinguishable from pH, level, and amount recited in the instant claims. With regard to claims 27-29, the intended use of the system fails to further limit the structure of the recited system.

Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/31636 McKay in view of Jansen 4,790,946 as above, and further in view of Humphrey et al. 4,172,786. The claims differ from the references as applied above by reciting that the system further includes an ozonator. Humphrey et al. disclose (see col. 3 lines 8-53) that it is known in the art to utilize an ozonator in a cooling water system to inhibit deposit formation on surfaces in contact with the cooling water. It would have been obvious to one skilled in the art to modify the references as applied above by utilizing the recited ozonator in view of the teachings of Humphrey et al., to aid in inhibiting deposit formation in the system.

Applicant alleges that the claimed pH, and level of metals, minerals, and chlorine product are an inherent result of the workings of the invention treatment system described throughout the specification. It is submitted that the claimed pH and levels are not described in the specification. Furthermore, applicant has not presented sufficient factual evidence to support the above allegation.

Applicant argues that the presently claimed invention provides for an invention which fills an unresolved need, that were it to be obvious would have been utilized prior to the inventors development. Applicant has not supplied sufficient factual evidence to support the above argument.

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Applicant argues that the present invention has seen both economic and environmental benefits, and provides a more efficient, economical and improved apparatus for control of scale, corrosion, and biofilm in a water system. Applicant has not supplied sufficient comparative evidence with the prior art used in the above rejections to support this argument.

Applicant argues that the most significant effect of the invention is to eliminate all chemicals currently used for fouling and for corrosion inhibitors. It is submitted that the teachings of McKay as applied above disclose (see page 9 lines 29-30) an apparatus for preventing scaling, biofilm, and corrosion within a condensing loop without the use of chemicals. Furthermore, the use of a means for adding chemicals is not excluded from the instant claims.

Applicant's citation of case law has been carefully considered but is not deemed pertinent due to the different circumstances involved in the instant application.

Applicants arguments concerning Humphrey et al. are based on the propriety of McKay, which is deemed properly applied for reasons stated above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,


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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is (571) 272-1160. The examiner can normally be reached on Monday through Friday from 6:30AM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Peter A. Hruskoci
Primary Examiner
Art Unit 1724

10/18/04